

Amendment and Response*Serial No.: 09/727,739**Confirmation No.: 4181**Filed: December 1, 2000**For: SOMATOSTATIN AND METHODS*

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Remarks

The Office Action mailed August 21, 2003 has been received and reviewed. Claim 1 having been amended and claims 16-20 having been added, the pending claims are claims 1-3 and 12-20. Reconsideration and withdrawal of the rejections are respectfully requested.

Applicants acknowledge, with appreciation, that the Examiner has extended his search and examination of claims 1-3 and 12-15 to include SEQ ID NOs:2 and 16-19, in addition to SEQ ID NO:15.

Request for Rejoinder under 37 CFR §1.121

Original claims 7-11, directed to a process for using a product, were previously withdrawn from examination pursuant an election filed in response to the Restriction Requirement mailed October 4, 2001, and were canceled, without prejudice, in the after-final Amendment submitted by the Applicants on March 18, 2003. Claims 7-11 are substantially resubmitted as new claims 16-20, with changes to include all the limitations of the examined product claims. Pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), withdrawal of the restriction requirement, and rejoinder and examination of new claims 16-20 is respectfully requested.

Finality of Office Action

The Office Action Summary, page 1 of the Office Action mailed August 21, 2003, indicated that the Office Action is a Final Office Action. The finality of the Office Action, however, was not indicated in the Detailed Action. The Office Action mailed August 21, 2003, was in response to Applicants' Request for Continuing Examination (RCE) under 37 CFR 1.114, filed on June 13, 2003. With this Office Action the Examiner extended the scope of his search and examination to include SEQ ID NOs:2 and 16-19. Applicants concluded that the finality of this Office Action was in error and premature (MPEP § 706.07(c)). In telephone conversations between the Examiner and Applicants' Representatives upon receipt of the Office Action, the

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Examiner confirmed that the Office Action mailed August 21, 2003 was not final; that the finality of the Office Action was, indeed, an unintentional error. To clarify the record, a copy of a corrected Office Action Summary, part of Paper 28, indicating "[t]his action is non-final," was received by facsimile from Examiner Li on November 6, 2003. A copy of this facsimile is included herewith as Exhibit A. Examiner Li is thanked for his courtesy and assistance in clarifying this matter.

The 35 U.S.C. §102 Rejection

The Examiner rejected claims 1 and 2 under 35 U.S.C. §102(b) as being anticipated by Moore et al. (*General and Comparative Endocrinology*, 98:253-261 (1995)). Specifically, the Examiner asserted that Moore et al. teaches a polypeptide that "meets the limitations of claim 1(d)" (page 3 of Office Action mailed August 21, 2003). This rejection is respectfully traversed. However, in view of the amendment of claim 1 deleting element (d), Applicants respectfully submit that the rejection of claim 1, and also claim 2 dependent therefrom, is obviated. Reconsideration and withdrawal of the rejection under 35 U.S.C. §102(b) is respectfully requested.

The 35 U.S.C. §103 Rejection

The Examiner rejected claims 12 and 13 under 35 U.S.C. §103(a) as being unpatentable over Moore et al. (*General and Comparative Endocrinology*, 98:253-261 (1995)), as applied to claims 1 and 2, in view of Hobart et al. (EU 46669 A1, March 3, 1982). This rejection is respectfully traversed. In view of the amendment to claim 1 deleting element (d), Applicants submit that Moore et al. is effectively removed as prior art and this rejection is obviated. Reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a) is respectfully requested.

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Summary

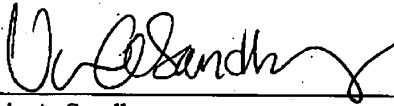
It is respectfully submitted that the pending claims 1-3 and 12-20 are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for
Sheridan et al.

By
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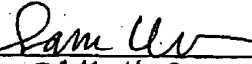
Nov 21, 2003

Date

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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Assistant Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 21st day of **NOVEMBER, 2003**, at 7:54 am (Central Time).

By: 
Name: SAM HER